

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHEL FEDER and JEAN ULRICH

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Appeal No. 94-0995  
Application No. 07/662,722<sup>1</sup>

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HEARD: March 23, 1999

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Before WINTERS, WILLIAM F. SMITH and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed February 28, 1991. According to appellants, this application is a continuation of Application No. 07/501,264, filed March 29, 1990, now abandoned; which is a continuation-in-part of Application No. 07/302,460, filed January 27, 1989, now abandoned.

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This appeal was taken from the examiner's decision rejecting claims 1 through 14, which are all of the claims in the application.

Claim 1, which is representative of the subject matter on appeal, reads as follows:

1. An aqueous silicone dispersion crosslinkable into elastomeric state by elimination of water therefrom under ambient conditions, comprising:

(A) 100 parts by weight of an oil-in-water emulsion of an "-T-(dihydroxy)polydiorganosiloxane stabilized with at least one anionic or nonionic surface-active agent, or mixture thereof;

(B) 1 to 100 parts by weight of an hydroxylated silicone resin containing, per molecule, at least two different recurring structural units selected from among those of the formulae:  $(R)_3SiO_{0.5}$ ,  $(R)_2SiO$ ,  $RSiO_{1.5}$  and  $SiO_2$ , wherein the radicals R, which may be identical or different, are vinyl, phenyl or 3,3,3,-trifluoropropyl radicals or linear or branched chain alkyl radicals containing from 1 to 6 carbon atoms, said resin having a hydroxyl group weight content of from 0.1% to 10%;

(C) 0 to 250 parts by weight of a nonsiliceous inorganic filler;

(D) 0.01 to 3 parts by weight of a metal curing catalyst compound; and

said dispersion having a solids content of at least 40%.

The references relied on by the examiner are:

|                            |           |               |
|----------------------------|-----------|---------------|
| Favre et al. (Favre)       | 4,143,088 | Mar. 6, 1979  |
| Grape et al. (Grape)       | 4,554,187 | Nov. 19, 1985 |
| Blizzard et al. (Blizzard) | 4,591,622 | May 27, 1986  |

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Japanese Abstract  
(JP 53-130752A)

53-130752A

Nov. 15, 1978

The issues presented for review are: (1) whether the examiner erred in rejecting claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Grape, Favre, and Blizzard; and (2) whether the examiner erred in rejecting claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over "JP 53-130752A."

On consideration of the record, we shall reverse these rejections.

#### BACKGROUND

The prosecution history of this application represents somewhat of a procedural quagmire and, therefore, we believe that a discussion of background information is necessary before reaching the dispositive issues on appeal.

In the Final Rejection (Paper No. 7), the examiner rejected claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over Grape. In a nutshell, the examiner's reasoning proceeded along these lines. First, the difference between Grape's composition and the claimed composition is component (B). In Grape, component (B) is an acyloxy or

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alkoxy-functional silicone resin whereas, in claim 1, that component is an hydroxylated silicone resin. Second, the instant specification acknowledges that appellants' component (B), the hydroxylated silicone resin, was known in the art at the time the invention was made (specification, page 11, first paragraph). Third, substitution of Grape's acyloxy or alkoxy-functional silicone resin with the known hydroxylated silicone resin is within the skill of the art (Paper No. 7, paragraph bridging pages 3 and 4). This, according to the examiner, establishes a prima facie case of obviousness. Fourth, the burden of persuasion shifts to appellants to rebut the prima facie case with a side-by-side comparison establishing that hydroxylated silicone resin gives rise to unexpectedly superior results compared with acyloxy or alkoxy-functional silicone resin.

The examiner's analysis in the Final Rejection was flawed. That appellants' component (B), the hydroxylated silicone resin, was known in the art at the time the invention was made, and that it was within the skill of the art to make the substitution of materials proposed by the examiner, begs the question. The real question is why? Why would a person

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having ordinary skill have used hydroxylated silicone resin in lieu of acyloxy or alkoxy-functional silicone resin in the composition of Grape? As stated in In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984):

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. [Citations omitted].

In the Final Rejection, the examiner did not point to any portion or portions of Grape or the acknowledged state of the prior art which would have suggested the desirability of the proposed modification of Grape's component (B). For this reason, the rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over Grape alone was flawed.

In the Appeal Brief (Paper No. 13), appellants espouse the very argument outlined above, namely, that the prior art relied on by the examiner does not suggest the desirability of the proposed modification of Grape's composition. Appellants also rely on the Favre and Blizzard patents which, according to appellants, teach away from the claimed invention. Appellants argue that each of Favre and Blizzard discloses component (B) of claim 1, the hydroxylated silicone resin, in

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compositions which are very different from the composition of Grape. Appellants reason that a person having ordinary skill in the art would not have been motivated to modify Grape's composition in the manner proposed by the examiner, given the context in which the hydroxy- lated silicone resin is used by Favre or Blizzard. According to appellants, the collective teachings of Grape, Favre, and Blizzard make it clear that acyloxy or alkoxy-functional silicone resin and hydroxylated silicone resin are not art-recognized equivalents or interchangeable materials.

#### DISPOSITION OF THE EXAMINER'S REJECTIONS

In the Examiner's Answer (Paper No. 14), the examiner does not repeat or refer to the rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over Grape alone. The only reasonable interpretation which these facts permit is that the rejection over Grape has been dropped. Paperless Accounting Inc. v. Bay Area Rapid Area Transit Sys., 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986).

In the Answer, the examiner enters the following new grounds of rejection: (1) claims 1 through 14 under 35 U.S.C.

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§ 103 as unpatentable over the combined disclosures of Grape, Favre, and Blizzard (Answer, page 3, last paragraph); and (2) claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over "JP 53-130752A" (Answer, page 7, first paragraph). We shall address these rejections in turn.

The Rejection Based on Grape, Favre, and Blizzard

As stated in Pro-Mold and Tool Co. v. Great Lakes Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996):

It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references.

Likewise, in the more recent opinion of In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998), the court stated that:

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.

Having carefully reviewed the Examiner's Answer, we agree with appellants that the examiner has not established adequate reason, suggestion, or motivation which would have led a person having ordinary skill in the art to modify the Grape

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reference in the manner proposed. For the reasons succinctly stated in the Appeal Brief, Favre and Blizzard teach away from, not toward, the claimed invention. The collective teachings of Grape, Favre, and Blizzard make it clear that acyloxy or alkoxy-functional silicone resin and hydroxylated silicone resin would not have been viewed as art-recognized equivalents or interchangeable materials in the composition of Grape. Favre and Blizzard do not "lend credibility to the examiner's position" (Answer, page 5). Each of those references discloses component (B) of claim 1, the hydroxylated silicone resin, in compositions which are very different from the composition of Grape.

The rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Grape, Favre, and Blizzard is reversed.

The Rejection Based on JP 53-130752A

Respecting the rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over "JP 53-130752A," the examiner has not furnished this merits panel with a copy of the Japanese patent in its entirety. A full text copy of the



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Japanese patent document, in the Japanese language or in the English language, is not of record. Rather, the examiner places reliance on what appears to be the print-out from a computerized search request. The print-out is in the form of an abstract.

Having reviewed the abstract, we find that this rejection is clearly erroneous. The composition in appellants' claim 1 includes component (B), an hydroxylated silicone resin, compared with a silane having at least three hydrolyzable groups disclosed in the abstract of JP 53-130752A. The examiner asserts that the claimed composition would have been obvious in view of the prior art disclosure of a silane having hydrolyzable groups, but the examiner offers no reasoning or evidence whatsoever supporting that assertion. The examiner provides no reasoning or evidence which would have led a person having ordinary skill from "here to there," i.e., from the prior art composition containing a silane having at least three hydrolyzable groups to the claimed composition containing an hydroxylated silicone resin.

The rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over "JP 53-130752A" is reversed.

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PROCEDURE

The unusual procedural aspects of this case warrant further discussion.

In the Reply Brief filed December 30, 1993 (Paper No. 16), appellants strenuously argued both of the new grounds of rejection set forth in the Examiner's Answer. These are (1) the rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Grape, Favre, and Blizzard; and (2) the rejection of claims 1 through 14 under 35 U.S.C. § 103 as unpatentable over "JP 53-130752A."

In a communication mailed April 22, 1994 (Paper No. 18), the examiner stated that:

The reply brief filed 12/20/93 [sic] has been entered and considered but no further response by the examiner is deemed necessary. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Manifestly, this does not constitute a substantive response to appellants' Reply Brief and does not explain why the arguments set forth in the Reply Brief fail to overcome the new grounds of rejection.

In the ensuing ORDER REMANDING TO EXAMINER mailed September 11, 1995 (Paper No. 19), this application was

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remanded to the examiner with instructions to provide appellants with an explanation why their Reply Brief did not overcome the new grounds of rejection. The examiner, however, did not file another office action or communication between September 11, 1995, and May 18, 1998, even though appellants filed two letters inquiring "as to the current status" of their application.<sup>2</sup>

Finally, on May 18, 1998, the examiner issued a Supplemental Answer (Paper No. 21), stating that:

Appellants are hereby informed that the Reply Brief does not overcome the new Grounds of rejection. The Examiner maintains his reasons for finally rejecting the claims. Said reasons and rationale are as indicated in the previous communications.

Again, this does not constitute a substantive response to appellants' Reply Brief and does not explain why the arguments set forth in the Reply Brief fail to overcome the new grounds of rejection.

We offer two comments on this unhappy state of affairs. First, the examiner's steadfast refusal to reevaluate

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<sup>2</sup> Status Inquiry filed May 30, 1997 (Paper No. 20);  
Second Status Inquiry filed October 14, 1997 (Paper No. 20½).

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patentability, in light of the arguments presented in appellants' Reply Brief, itself constitutes reversible error. As stated in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. [Citation omitted].

This the examiner did not do. Second, regardless of two status inquiries, the examiner failed to issue any form of communication to appellants between September 11, 1995, and May 18, 1998, responding to the ORDER REMANDING TO EXAMINER (Paper No. 19). This inordinate delay in communicating with the applicants can hardly be said to be "customer friendly."

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CONCLUSION

For the reasons set forth in the body of this opinion,  
both of the examiner's rejections newly presented in the  
Examiner's Answer are reversed.

REVERSED

|                             |   |                 |
|-----------------------------|---|-----------------|
| SHERMAN D. WINTERS          | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) |                 |
| WILLIAM F. SMITH            | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| HUBERT C. LORIN             | ) |                 |
| Administrative Patent Judge | ) |                 |

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